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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,954	08/28/2001	Ulrich Meisen	Mo-6419/LeA 34,865	5188
34947	7590	03/18/2004		
BAYER CHEMICALS CORPORATION PATENT DEPARTMENT 100 BAYER ROAD PITTSBURGH, PA 15205-9741			EXAMINER RODEE, CHRISTOPHER D	
			ART UNIT	PAPER NUMBER
			1756	

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/940,954	MEISEN, ULRICH	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher D RoDee	1756	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 4 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

The amendment filed 16 December 2002 remains objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the content of Mn as being determined by ICP-OES (spec. p. 9). The specification as filed states that the content of Mn is determined by atomic absorption spectroscopy.

The current amendment reintroduces the statement that Mn is determined by atomic absorption spectroscopy but fails to remove the statement that Mn is determined spectroanalytically by ICP-OES. Because the specification still includes the new matter the objection must be retained. Additionally, applicants are advised that the amendment to the specification was not made pursuant to 37 CFR 1.121 because added material was not underlined and already existent material was underlined. All future amendments must conform to regulations.

The misspelling of "silicon" (i.e., "silicone") in the Abstract must be corrected in response to this Office action.

### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Okano *et al.* in US Patent 5,578,375 or Taya *et al.* in US Patent 5,296,325.

These rejections were set forth in the last Office action and are incorporated here. Applicants traverse the rejection because the Examiner has not shown that the magnetites of the claimed toner would contain silicon. Specifically, applicants state, "the Examiner correctly stated that the referenced magnetite contains no silicon. Yet the Examiner concluded, without facts or technical reasoning, that the referenced magnetite would still contain silicon."

The basis for the Examiner's reasoning that the reference's magnetites would contain an amount of silicon within the scope of the claims is consistent with the specification disclosure. In each example no silicon-containing reactants are disclosed. For example, in specification Example 1 on page 11 the reactants are: a sodium hydroxide solution and an iron(II) sulfate solution. These reactants are treated in various manners under a controlled nitrogen atmosphere and, apparently, an oxygen-containing atmosphere to produce a magnetite having a silicon content of 0.001 wt %. No silicon-containing reactants are specifically disclosed in this example, or anywhere in the specification disclosure. Consequently, it appears that the required silicon content is present as a trace material in the disclosed reactants.

The applied art is similar in that there are no silicon-containing reactants disclosed or required for formation of the magnetites. However, the specification shows silicon to be present, apparently as a minimal or trace material, in the produced magnetite and that such a trace amount of silicon falls within the scope of the instant claims. The silicon must come from the material reactants (e.g., iron sulfate or sodium hydroxide, which are also used in the applied art). The specification establishes that trace amounts of silicon are present in the magnetite reactants. These same or similar reactants are used in the applied art.

The instant claims include the presence of as little as one atom of silicon in the magnetite structure. There is, based on the totality of evidence, sufficient reason to believe that the magnetites of the applied art have such minimal amounts of silicon as to fall within the scope of the claims.

The rejection is maintained.

#### ***Allowable Subject Matter***

Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1756

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHRISTOPHER RODEE  
PRIMARY EXAMINER

cdr  
9 March 2004